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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/712,584	11/14/2000	Daniel Arturo Delfin Farias	SJO919990173	9711

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EXAMINER
O'CONNOR, GERALD J

ART UNIT	PAPER NUMBER
3627	6

DATE MAILED: 10/08/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	Applicant(s)
09/712,584	Farias et al.
Examiner	**Art Unit**
O'Connor	3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *three* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☐ Responsive to communication(s) filed on _____.

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-65* is/are pending in the application.

4a) Of the above, claim(s) *none* is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-65* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on *Nov 14, 2000* is/are a) ☒ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). *5*
4) ☐ Interview Summary (PTO-413) Paper No(s). _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. The following is a quotation of 35 U.S.C. 101:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-18 and 58-65 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Though performing the method of the instant invention, as disclosed, requires the use of computers, claims 1-18 and 58-65 fail to recite any limitation that would require a computer or any other structural element that would necessarily require a computer (simply a "database" and/or a "network," as the claims broadly recite, do not).

Current Office policy is to reject as non-statutory under § 101, method claims that fail to require the use of any computer, for failing to fall within the technological arts.

To overcome such a rejection, a positive limitation in the body of the claim is required to recite either the use of a computer, *per se*, or else some other element that would inherently and necessarily require a computer. In this case, for example, the "computer" recited in claim 19 is sufficient to avoid or overcome this type of rejection (although see below for the rejection of claim 19 under 35 U.S.C. 112, second paragraph, for insufficient antecedent basis for this recited element).

Claim Rejections - 35 USC § 112, Second Paragraph

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 13-19, 32-38, and 51-57 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are indefinite because the following recitations, found therein, lack a sufficient antecedent basis:

- In claim 13, lines 2 and 6-7: "the acquiring entity" (3 pl);
- In claim 14, line 3: "the acquiring entity";
- In claim 17, line 2: "the acquiring entity";
- In claim 18, lines 2 and 6-7: "the acquiring entity" (3 pl);
- In claim 19, line 2: "the acquiring entity computer";
- In claim 19, lines 3 and 5: "the acquiring entity" (2 pl);
- In claim 32, lines 2 and 7-8: "the acquiring entity" (3 pl);
- In claim 33, line 3: "the acquiring entity";
- In claim 36, line 2: "the acquiring entity";
- In claim 37, lines 2 and 7-8: "the acquiring entity" (3 pl);
- In claim 38, line 2: "the acquiring entity computer";

- In claim 38, lines 3 and 5: "the acquiring entity" (2 pl);
- In claim 51, lines 2 and 8-9: "the acquiring entity" (3 pl);
- In claim 52, line 3: "the acquiring entity";
- In claim 55, line 2: "the acquiring entity";
- In claim 56, lines 2 and 8-9: "the acquiring entity" (3 pl);
- In claim 57, line 2: "the acquiring entity computer"; and,
- In claim 57, lines 3 and 5: "the acquiring entity" (2 pl).

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-38 and 58-65, as best understood in light of any rejections made hereinabove under 35 U.S.C. 101 and/or 35 U.S.C. 112, are rejected under 35 U.S.C. 102 as being clearly anticipated by the admitted prior art, as described in the written specification.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 39-57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Graves et al.,

Graves et al. disclose a computer method for ordering products by means of a network of computers, which computer method clearly anticipates the instant claims, except that the method of Graves et al. involves only two entities (a manufacturer ordering directly from a supplier) rather than three entities (a manufacturer, receiving supplies from a distributor/middleman, the distributor/middleman first receiving the supplies from a supplier).

However, third party distributors/middlemen are well known to those of ordinary skill in the art, hence, obvious elements to include in such a method. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the computer method of Graves et al. so as to duplicate its functionality, as required, to form a three link chain instead of a two link chain, in order to accommodate an intermediate third party, such as a distributor/middleman, since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results, and since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to the disclosure.

10. Any inquiry concerning this communication, or earlier communications, should be directed to the examiner, Jerry O'Connor, whose telephone number is (703) 305-1525, and whose facsimile number is (703) 746-3976.

GJOC
September 30, 2002

Gerald J. O'Connor
Patent Examiner
Group Art Unit 3627